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Paper No. 8

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MAILED

DEC 03 2003

Technology Center 2100

In re Application of: Tatebayashi et al.)
Application No. 09/638,616) **DECISION ON PETITION FOR**
Attorney Docket No. NAKI-BM08) **ACCELERATED EXAMINATION**
Filed: August 15, 2001) **UNDER 37 CFR §1.102(d) AND MPEP**
For: ENCRYPTION METHOD,) **§ 708.02(VIII): ACCELERATED**
ENCRYPTION APPARATUS,) **EXAMINATION**
DECRYPTION METHOD, AND)
DECRYPTION APPARATUS)

This is a decision on the petition, filed June 24, 2003, under 37 CFR § 1.102(d), in accordance with MPEP § 708.02(VIII), requesting the accelerated examination of the above identified application. The petitioners filed a facsimile copy of the petition request on June 27, 2003 and a decision was rendered July 24, 2003 setting a two-month period to request reconsideration of that decision.

The papers filed June 24, 2003 include a petition, an information disclosure statement (PTO-1449), a copy of the references cited thereon, and a change of address based upon Customer No. 21611. In light of the papers now matched to the application, the previous decision was based upon an incomplete record. The decision was based, in part, on deficiencies relating to the fact the references being discussed in the petition had not been submitted and it was not mailed to the proper address. Therefore, the previous decision is withdrawn.

Issues

In support of the petition, petitioners have provided a fee, a statement that a European Search Report had been conducted and references cited, and remarks provided regarding the Ohmori EP application, the Stallings Williams, article, and the Charnes, *et al.* article. The petitioners also discuss the advantageous feature recited in Claim 1.

Decision

According to the MPEP §708.02 (VIII), the prerequisites to be met by applicant for a grantable petition for Accelerated Examination under 37 CFR § 1.102(d) includes the following:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);

(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status. The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed. If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention. If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn. Divisional applications directed to the nonelected inventions will not automatically be given special status based on papers filed with the petition in the parent application. Each such application must meet on its own all requirements for the new special status;

(C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petition fails to fully comply with the requirements set forth in sections (B) and (E) above.

The petition omits a statement that all claims are directed to a single invention, and if the examiner later determines otherwise, that the applicants would elect without traverse. The petition is also deficient in submitting a detailed discussion of the references which points out with the particularity required under 37 CFR § 1.111 how the claimed subject matter is patentable over the references.

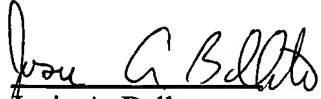
The references were cited in a European Search Report, but the report was omitted and the petitioners are silent as to whether the pending U.S. claims are equivalent to the claims that were the subject of the search report. The discussion mentions "Ohmori EP" but that citation does not match the citation found on pages 1-2 of the petition. As the reference is now found in the file wrapper, it can be seen that Ohmori is equivalent to EP 0 874 496 A.

A review of petitioners' discussion of this reference and the other references shows each discussion has the same problem. There are six independent claims pending in the application. The petitioners' discussion of what the references lack is at variance with the actual claim limitations in the independent claims. In addition, the petitioners only specifically discuss Claim 1 and fail to discuss the language or limitations in Claims 4, 5, etc.. This discussion does meet the standard of a detailed discussion which points out with the particularity required under 37 CFR § 1.111.

The petition is **DISMISSED**.

The application file will be forwarded to the central files for Technology Center 2100 to await examination in its proper turn based on its effective filing date. Petitioners are entitled to one opportunity to perfect the request in a renewed petition to make special. Such a request should

be filed within two (2) months of the mailing date of this decision. Telephone inquiries should be directed to the undersigned at (703) 308-0269.

A handwritten signature in black ink, appearing to read "Josie A. Ballato". The signature is written in a cursive, flowing style.

Josie A. Ballato

Special Programs Examiner

Technology Center 2100

Computer Architecture, Software, and Information Security